

### ***Remarks***

In the Office Action, the Examiner noted that claims 1-20 are pending in the application, that claims 4-5, 8-16, 19-20 are objected, and that claims 1-20 are rejected. By this amendment, repeat claim 4 has been cancelled, and claims 1-20 have been amended. Thus, claims 1-20 are now pending in the application. The Examiner's rejections are respectfully traversed below.

### ***Claim Objections***

Claims 4-5, 8-16, 19-20 stand objected to under 37 CFR 1.75(c) as being in improper multi-dependant claim (MDC) form.

Claims 4's MDC language "The apparatus for playing a game as defined in claim 1 wherein" is proper claim language under 37 CFR 1.75(c), and is not listed as unacceptable claim language, See MPEP 608.01(n) examples. Additionally, such language is permissible and frequently used in this area of art, See US Patent application 5,816, 574 as an example of such. Additionally, Claim 4 does not depend on another independent claim and thus is a proper multi-dependant claim that should have received examination during the first office action.

Accordingly, Applicant respectfully submits that the claims satisfy the requirements under 37 CFR 1.75 and MPEP 608.01(n). Withdrawal of this objection is respectfully requested.

Applicant concedes that claims 5, 9-16 improperly relies upon another MDC. Applicant has amended the claims to correct the dependency as required under 37 CFR 1.75 and MPEP 608.01(n).

Claims 8's MDC language "The method of playing a game as define in anyone of claims 6-7 wherein" is proper claim language under 37 CFR 1.75(c), and is not listed as unacceptable claim language, See MPEP 608.01(n) examples. Additionally, such language is permissible and

frequently used in this area of art, See US Patent application 5,816, 574 as an example of such usage. Additionally, Claim 6 does not depend on another MDC and thus is a proper multi-dependant claim that should have received examination during the first office action.

Accordingly, Applicant respectfully submits that the claims satisfy the requirements under 37 CFR 1.75 and MPEP 608.01(n). Withdrawal of this objection is respectfully requested.

Applicant concedes that the number of claims is not in accordance with 37 CFR 1.126. Examiner has cancelled repeat claim 4, properly numbered repeat claim 4 as new claim 15, also cancelled.

#### *Final Rejection, When Proper*

Under 706.07(a) a final rejection is not proper on a second action or subsequent actions on the merits where the examiner introduces a new ground of rejection that is neither necessitated by the applicant's amendment of the claims nor based on information submitted in an information disclosure statement. Here, applicant introduces no amendments to claims 4 and 6, which should have been properly examined during the first office action and not rejected for improper MDC language or dependency. Furthermore, a second or any subsequent action on the merits in any application or re-examination proceeding will not be made final if it includes a rejection, on newly cited matter. See MPEP § 609 paragraph (B)(2). Here no matter has been cited, and any final rejection could only be limited to those references cited in the first office action.

Applicant respectfully request that a second non-final action be issued.

#### *Rejections Under 35 USC 101*

Claims 6-16 are rejected under 35 USC § 101 by applicants claiming of human beings as a limitation, which is not statutory subject matter. Applicant has amended claims 6-16 to remove the human being limitation. Withdrawal of these rejections is respectfully requested.

### ***Rejection Under 35 USC 112***

Claims 17 and 20 stand rejected under 35 USC Sections 101 and 112, as not being supported by either the specification by either a specific asserted utility or well established utility, and applicant is claiming both an apparatus and method.

Applicant has amended claims 1-5 to clearly claim the game play apparatus only, and has amended claims 17-20 to clearly claim the method of game play only.

With respect to examiner's claim that the claimed invention is not supported by either the specification by either a specific asserted utility or well established utility and one of ordinary skill in the art clearly would not know how to use the claimed invention, this is rejection is respectfully traversed. Educational board games are well known in the prior art and in particular board games, specifically those which are designed and developed to teach or improve a person's vocabulary or language skills as the present invention. Applicant also refers examiner to Page 3, L 18-24 where the object of the present invention is clearly stated:

“The device according to the present invention departs from the conventional concepts and designs of the prior art, and in so doing *provides a method of learning a foreign language that is more interesting to the user while providing a broad range of topics and skill levels*. The present invention addresses the shortcomings in the prior art with respect to its approach to teaching and reinforcing the learning of a new language and the ease of flexibility of the game to change various topics and adjust skill level as the user desires.”

With respect to examiners rejection that one of ordinary skill in the art clearly would not know how to use the claimed invention, claim 17 clearly lists the game play methodology that is

fully supported and described in the detailed description. The game of the present invention is currently in production, distribution and use in the embodiment as illustrated in the figures and incorporating the instruction for game play as claimed and described within the detailed description and those of ordinary skill in the art (language teaches at all levels) have had no difficulty in using the claimed invention. Evidence of such an effect can be provided at the examiner's request.

With respect to examiner's rejection under 35 USC § 112, 2<sup>nd</sup>, that with respect to claims 6, 7, and 17, that the claim limitations of "the level or players" and "the target language" in the claims is has insufficient antecedent basis, applicant directs examiners attention to the following specific locations in the patent application.

With respect to "the level or players", neither claim 6, 7, or 17 recites "the level or players" as quoted by the examiner and such rejection is improper and Applicant respectfully requests withdrawal.

If, in the office action, examiner was attempting to express that "levels" and "players" did not have proper antecedent basis in the application, Applicant directs examiner's attention to Page 9, L 1-5, where the various "levels" of the game are defined. Additionally, "levels" and "players" are well known terms in the art, used in their plain meaning and need no definition and their use in the detailed description is clear to allow one of ordinary skill in the art to understand the invention.

With respect to "the target language", Page 4, L 20-21, Page 8, L 10, 15, 21, and Page 9, L 20, clearly provide antecedent basis that "the target language" is the language a player is attempting to learn and may be a foreign language or native language.

With respect to examiner's rejection that claims 6-20 are indefinite under 35 USC § 112, 2<sup>nd</sup>, for failing to particularly point out the invention, applicant respectfully disagrees. Claims 1-5

clear claim the apparatus for enabling the game play of the present invention while claims 17-20 clearly claim the method or process of game play according to the present invention.

With respect to examiner's rejection that claims 6 and 17 are run on sentences with limitation "on a game card, or from the result of a spinner" is not clear, applicant agrees. Both claims have been amended to clarify that a marker's movement is either based the direction received by a game card or from the result of a spinner device.

With respect to examiner's rejection in paragraph 10 of the Office action that claims 1-20 "are *generally* narrative and indefinite", an Examiner must clearly define the problem and why it is a problem in connection with the issue of claim definiteness in order to provide an applicant or any reviewing authority with the information necessary to evaluate the Examiner's position fairly. If the rejection under section 112, second paragraph does not specifically address the necessary issues, the rejection can be attacked for failing to establish a *prima facia* case of indefiniteness.

The Manual of Patent Examining Procedure (MPEP) provides the following: "The examiner's focus during examination of claims for compliance with the requirement for definiteness...is whether the claim meets the threshold requirements of clarity and precision, not whether more suitable language or modes or expression are available." See Manual of Patent Examining Procedure § 2173.02 (6<sup>th</sup> ed. 1995). An Examiner must specifically reject each claim, using the word "reject", and must clearly and fully state the grounds for rejection. Absent specific rejections and explanations of indefiniteness, an Examiner's comments are to be taken as a suggestion for a review of the claims to ensure that all claim errors are detected and corrected.

With respect to examiner's rejection that claims 1-20 are "*generally* narrative and indefinite", applicant respectfully submits that the claims 1-20, as amended, conform with current US practice and all grammatical errors have been corrected. If Examiner upon review, and before

the issuance of a second office action would like to discuss the claim language, Applicant respectfully invites Examiner to contact the Attorney/Agent of record to discuss, for the purposes of submitting any preliminary amendments before issuance or examination under a second office action.

Accordingly, Applicant respectfully submits that the claims satisfy the requirements under 35 USC Sections 101 and 112. Withdrawal of this rejection is respectfully requested.

#### ***Rejections Under 35 USC 102***

Claims 1-2, 17-18 stand rejected under 35 USC Section 102(b) as anticipated by *Lynn*.

Applicant respectfully submits that claims 1-2, 17-18 are not anticipated by *Lynn*. A prima facia case of anticipation is established when the Examiner provides a single reference that teaches or enables each of the claimed elements (as arranged in the claim) expressly or inherently as interpreted by one of ordinary skill in the art. Accordingly an applicant who is able to prove that any one of these five elements is not present will effectively prevent the prima facia case of anticipation from being established.

With respect to claims 1 and 2, Applicant respectfully submits that the subject matter claimed therein patentably distinguishes over *Lynn*. *Lynn* is directed toward a playing surface for a game having a variety of pathways providing obstacles to player's movements and further providing countless variations of game play as well as adding an element of chance effecting each player's strategy. See Col. 2, L 4-9. In other words, the game board provides a playing surface that has a changing path from start to finish. Conversely the removable discs of the present invention provide, not for rotatable game spaces along the track that change a player's

path from start to finish, but a removable game section that allows variations in game play based on skill level and subject desired for language learning.

Specifically, claim 1 recites “a set of question disks that provide for the insertion of additional adjacent spaces where the adjacent spaces written on one face of the question disk create circular areas with the appearance of zones radially extending around the center.” While *Lynn* does teach the use of a removable questions disc it does not teach nor suggest that the questions disc created additional spaces along the tracks progression which are “adjacent spaces written on one face of the question disk create circular areas with the appearance of zones radially extending around the center.”

Examiner points to Col. 8, L 25-35 to support anticipation of a disc with questions, put this reliance is improper. Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claim invention, *arranged as in the claim*.

*Lindermann Maschinenfabrik GMHB v. American Hoist and Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984) (emphasis added). This, the examiner has not done. Thus, Applicant respectfully submits that claim 1 patentably distinguishes over *Lynn*. Withdrawal of this rejection is respectfully requested.

Col. 8, L 25-35 does not teach the use of questions for the game piece positions (30) along the path lines (48), reading just above Col. 8 at lines 7-25, *Lynn* clearly explains that that chart present at Col. 8, L 25-35 and relied upon by the examiner is completely unrelated to questions but is a formula to “provide line matches and mismatches.” See Col. 8, L 8-8. Additionally, “questions” are not those answered in the game but refer the player’s action to be taken, specifically “the first question is whether the player will have the option to jump using the jump line either left or right...” This is not a questions present to the player, but merely a

decision the player must make. The present invention is clearly distinctive in that upon lading of an “adjacent space, crated by radially extending lines on the question disc”, not taught by *Lynn*, a player is faced with an actual question, not merely a decision. Applicant respectfully requests withdrawal of this rejection based on the lack of *Lynn* to teach a removable question disc with “adjacent spaces written on one face of the question disk create circular areas with the appearance of zones radially extending around the center” as that of Claim 1 as a physical embodiment and the method of use as claimed in claim 17.

With respect to defendant claim 2, which depends directly on claim 1 and incorporates all the limitations of claim 1 is therefore patentably distinguishable over *Lynn* for the reasons discussed in connection with claim 1. Withdrawal of these rejections is respectfully requested.

With respect to claims 17-18, applicant request that the claims be re-examined as method claims, and not as apparatus claims. The claim language previously objected and rejected to has been corrected in amended claims 17-18 to clearly indicate applicant’s intention of claiming a method of game play and not an apparatus in claims 17-18. Withdrawal of these rejections is respectfully requested.

### ***Rejections Under 35 USC 103***

Claims 3 and 6-7 stand rejected under 35 USC Section 103(a) as being obvious in view of *Lynn*. With respect to defendant claim 6, which depends directly on claim 1 and incorporates all the limitations of claim 1 is therefore patentably distinguishable over *Lynn* for the reasons discussed in connection with claim 1. Withdrawal of these rejections is respectfully requested.

With respect to claims 6-7 Applicant concedes that it is common knowledge that answers are always according to a player’s skill level, but the present invention present questions

according to a player's skill level and requires answers that require a varying skill to complete. Claims 6-7, as originally filed, did not contain what the examiner states as "the important thing", that being "the limitations do not specifically spell skills clearly with respect to questions of particular skills and not answers to particular skills.

Claim 6 has been amended to specifically include claim limitations for five types of specific questions squares that specifically spell skills clearly with respect to questions of particular skills. For example, challenge squares require players to give a variety of answers based on their skill level; expression squares require players to translate the meaning from their native language into the target language; phrase specific squares require players to make making a question utilizing a provided sentence structure or utilize a specific phrase with a picture card or any picture; survival squares require players to translate a set phrase into a target language; and talk about squares require players to think of a suitable sentence in which to use a word determined by the space. These five specific question types are clearly enabled and discussed in the detailed description and were originally filed as limitation of Claim 19, a dependant claim of claim 17, which was not rejected by prior art. Withdrawal of this rejection is respectfully requested.

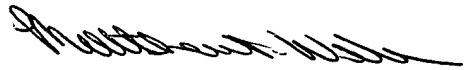
With respect to dependant claim 7, which depends directly on claim 6 and incorporates all the limitations of claim 6 is therefore patentably distinguishable over *Lynn* for the reasons discussed in connection with claim 6. Withdrawal of these rejections is respectfully requested.

*Conclusion*

For all the reasons advanced above, Applicant respectfully submits that the application is in condition for allowance and that action is earnestly solicited.

In the event that an extension of time is required, or may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely.

Respectfully submitted,



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